UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/087,406	SIMPSON ET AL.
	Examiner	**Art Unit**	
	Craig W Kronenthal	2623	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
    closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-30</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-30</u> is/are rejected.

7) ☒ Claim(s) <u>7,8 and 25-30</u> is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>01 March 2002</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage

        application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date <u>8/5/03</u>.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 7 is objected to because of the following informalities:

- On line 1 of claim 7, "step of identifying" should be changed to "step of selecting" in accordance with the language used on line 4 of claim 1.

- On line 2 of claim 7, the very last word was misspelled "imagining" when it should be "imaging".

Appropriate correction is required.

2. Claim 8 is objected to because of the following informalities:

- On line 1 of claim 8, "step of identifying" should be changed to "step of selecting" in accordance with the language used on line 4 of claim 1.

Appropriate correction is required.

3. Claim 25 is objected to because of the following informalities:

- The preamble on lines 1-2 of claim 25, should be replaced with "A computer readable medium storing computer readable instructions for performing the steps of:" in accordance with 35 USC 101.

Appropriate correction is required.

4. Claims 26-30 are objected to because of the following informalities:

- On line 1 of claims 26-30, "The program of" should be replaced with "The computer readable medium storing computer readable instructions for performing the steps of".

Appropriate correction is required.

5. A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See MPEP § 608.01(n). Claim 30 depends on claim 26, but is separated by claims 27-29.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5 and 6 recite the limitation "the step of storing" in the first lines of both claims 5 and 6. There is insufficient antecedent basis for this limitation in the claim. To overcome this rejection:

- A step of storing may be added to claim 1

Or

- Claims 5 and 6 may be rewritten, for example, "The method of claim 1, further

  comprising a step of storing the watermark composition, wherein the step of

  storing the watermark..."

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form

the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by
> another filed in the United States before the invention by the applicant for patent or (2) a patent
> granted on an application for patent by another filed in the United States before the invention by the
> applicant for patent, except that an international application filed under the treaty defined in section
> 351(a) shall have the effects for purposes of this subsection of an application filed in the United States
> only if the international application designated the United States and was published under Article 21(2)
> of such treaty in the English language.

8. Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Terasaki

(Pub. No. US 2002/0037091 A1).

Regarding Claim 1: Terasaki discloses a method for adding a watermark, comprising

the steps of:

- Accessing a watermark service (Fig. 1, 2) [The client (Fig. 1, 3) accesses the

  web server (2) (p. 2, [0027], lines 4-5). The web server (2) represents a

  watermark service for inserting watermark information (p. 2, [0028], line 1).];

- Selecting a watermark image from the watermark service [The watermark insertion section (Fig. 1, 21) selects the electronic watermark from a storage unit (Fig. 1, 23), which is considered as part of the entire watermark service (p. 2, [0030], lines 1-2). The watermark itself is considered an image since it is formed into a bit plane and the bit plane is added to an image (p. 2, [0038], lines 13-15). The watermark is also shown as an image in Figure 2 as a dark parallelogram.];

- Selecting a target composition (Fig. 1, 23a) using the watermark service [The watermark insertion section (21) also selects the low resolution data (23a), which represents the target composition from the storage unit (23), which is considered a part of the entire watermark service (p. 2, [0030], lines 1-6).];

- Generating a watermark composition comprising the target composition and the watermark image using the watermark service [The watermark insertion section (21) generates the watermark composition by replacing a bit plane of the low resolution data (23a) with a watermark image (p. 2, [0038], lines 9-15). Figure 2 illustrates this procedure.].

Regarding Claim 2: Terasaki discloses the method of claim 1, wherein the step of accessing comprises using an imaging extension [The client (Fig. 1, 3) must make a request to the web server (Fig. 1, 2) before any information is transmitted. Therefore, it is inherent that the request be performed by a means equivalent to an imaging extension (p. 2, [0027], lines 3-5).].

Regarding Claim 3: Terasaki discloses the method of claim 2, wherein the imaging

extension is operable in a browser (Fig. 1, 32) [The browser (32) is specifically

mentioned as the means for making the request, so it is understood that the imaging

extension equivalent is operable in the browser (32) (p. 2, [0034]).].

Regarding Claim 4: Terasaki discloses the method of claim 2, wherein the imaging

extension (Fig. 1, 22) is operable in a web server (Fig. 1, 2) [The image distribution

section (22) acts as an imaging extension within the web server (2) since it distributes

the data from the web server (2) to the appropriate client (3) (p. 2, [0031], lines 1-3).].

Regarding Claim 5: Terasaki discloses the method of claim 1, *further comprising a step*

of storing the watermark composition, wherein the step of storing the watermark

composition comprises retaining both the at least one watermark image and the at least

one target composition within a composition store (Fig. 1, 34) [The browser (Fig. 1, 32)

stores the watermark composition (23a) in a storage unit (34) (p. 3, [0044], lines 6-10).

The watermark composition is the low resolution data (23a) output from the web server

(2), as explained regarding claim 1.].

Regarding Claim 6: Terasaki discloses the method of claim 1, *further comprising a step*

of storing the watermark composition, wherein the step of storing the watermark

composition comprises retaining web content such that when the web content is served

to a remote service web browser, the remote service generates a hard-copy product

using the watermark composition [The client (Fig. 1, 3) has a data selection driver (Fig.

1, 31), which connects the storage unit (Fig. 1, 34), storing the watermark composition

(23a), to a printer (Fig. 1, 36), capable of making a hard-copy. The browser (Fig. 1, 32)

represents a remote service web browser since it is separate from the web server (Fig.

1, 2). The browser (32) receives web content from the web server (2), retains the

content in the storage unit (34) (p. 3, [0044], lines 6-10) for access by the data selection

driver (31) to pass the data to a printer (36) (p. 3, [0049], lines 30-36).].

Regarding Claim 7: Terasaki discloses the method of claim 1, wherein the step of

selecting at least one target composition comprises retrieving imaging data from a

personal *imaging* repository [The storage unit (Fig. 1, 23) represents a personal imaging

repository, from which a target composition (Fig. 1, 23a) is retrieved (p. 2, [0028], lines

1-6).].

Regarding Claim 8: Terasaki discloses the method of claim 1, wherein the step of

selecting at least one target composition comprises selecting a default composition [The

predetermined bit plane of the target composition is a default composition in which the

watermark image is placed (p. 2, [0038], lines 10-15).].

9.   Claims 9-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Ito et al.

(Pub. No. US 2001/0013097 A1). (hereinafter Ito)

Regarding Claim 9: Ito discloses a system for adding a watermark to a document, comprising:

- Means for selecting at least one watermark image [Inside the ID imprinter (18) is an ID reader (Fig. 4, 30), which selects from an ID holder (Fig. 3, 16) at least one watermark image (p. 2, [0038], lines 3-5).];

- Means for identifying at least one target composition [The communication section (Fig. 3, 10), which acts as the identifying means and belongs to the PC (4), receives the requested target composition from a content manager via a network (Fig. 1, 9).];

- Means for associating the at least one watermark image with the at least one target composition to generate a watermark composition [The ID imprinter (18) acts to generate a watermark composition by combining (Fig. 4, 34) an ID, representing the watermark image, with a decoded image, representing the target composition (p. 2, [0035], lines 7-8).];

- Means for storing the watermark composition [The memory (Fig. 3, 26) stores the imprinted image, representing the watermark composition, output from ID imprinter (18) (p. 2, [0039], lines 16-17).].

Regarding Claim 10: Ito discloses the system of claim 9, wherein the means for selecting comprises an imaging-client device [The PC (Fig. 3, 4) contains the ID imprinter (Fig. 3, 18) that performs the selection. The PC (Fig. 3, 4) is an imaging-client device (p. 2, [0032], lines 1-2).].

Regarding Claim 11: Ito discloses the system of claim 10, wherein the imaging-client

device comprises a browser [The imaging-client device, represented by a PC (Fig. 3, 4),

contains a browser, represented by a viewer (Fig. 3, 12) (p. 2, [0033], lines 5-7 and

[0035], lines 1-2).].

Regarding Claim 12: Ito discloses the system of claim 11, wherein the browser contains

web content, the web content comprising information reflective of the watermark image

[The viewer (Fig. 3, 12) may be a plug-in device that is incorporated into existing

internet browsers in which case its contents would be web contents. Furthermore, the

viewer (12) contains the ID holder (Fig. 3, 16) that contains information reflective of the

watermark image (IDs) (p. 2, [0035], lines 9-13).].

Regarding Claim 13: Ito discloses the system of claim 9, wherein the means for

identifying at least one target composition comprises an imaging extension [The

communication section (Fig. 3, 10) is understood to be the equivalent of an imaging

extension since the user transmits a request for content through the communication

section (10) and the contents are received by the communication section (10) (p. 2,

[0034] lines 3-8).].

Regarding Claim 14: Ito discloses the system of claim 13, wherein the imaging

extension communicates with a personal-imaging repository [The imaging extension

represented by the communication section (Fig. 3, 10) communicates with a content

manager, which is part of a server (Fig. 1, 2). The server (2) therefore acts as a

personal-imaging repository for providing contents (p. 2, [0034], lines 3-8).].

Regarding Claim 15: Ito discloses the system of claim 14, wherein the imaging

extension comprises part of a browser [Although the communication section (Fig. 3, 10)

is shown outside the browser (Fig. 3, 12) it is understood that an internet browser

belonging to a PC, encompasses this section (10) in addition to the viewer (12) (p. 2,

[0035], lines 11-13).].

Regarding Claim 16: Ito discloses the system of claim 9, wherein the means for

associating comprises logic in an imaging extension [It is inherent that the combiner

(Fig. 4, 34) of the ID imprinter (Fig. 3, 18) comprises logic in an imaging extension. An

image extension is needed to access the watermark image (ID) and target composition

(decoded image). Also since the combiner (34) is an electrical component it must be

made from logic.].

Regarding Claim 17: Ito discloses a system for adding a watermark to a document,

comprising:

- A server including imaging-service content, the server coupled to a network, the

  imaging-service content comprising the means of adding at least one watermark

  image [The server (Fig. 1, 2) is coupled to a network (Fig. 1, 9). The server (2)

contains contents (Fig. 1, not numbered), which it supplies to a client device such

as a PC (Fig. 1, 4) (p. 2, [0032], lines 1-2). Furthermore, the server (2) contains

a content manager (not shown), which adds the contents including an ID,

representative of a watermark image, to the ID holder (Fig. 3, 16) (p. 2, [0035],

lines 9-11). Also this content manager transmits content including a viewer (Fig.

3, 12), which is a means for adding at least one watermark (p. 2, [0034], lines 5-

7).];

- A computing device coupled to the network, the computing device configured

with a browser, wherein the browser is configured to receive the imaging-service

content, extract data reflective of the at least one watermark image designated

for integration in a product with at least one target composition stored in a data

storage device communicatively coupled with the computing device, and

generate a watermark composition [The computing device is the PC (4), which is

also coupled to the network (9). The PC (4) contains a viewer/browser (Fig. 3,

12), which is configured to receive and extract the content provided by the server

(2) (p. 2, [0035], lines 1-6). The browser (12) contains an ID imprinter (Fig. 3,

18), which contains a ID reader (Fig. 4, 30), which extracts an ID from the ID

holder (16). The PC (4), in addition to receiving an ID from the server (2) via the

network (9) and ID holder (16), receives a target composition by way of a

communicatively coupled storage medium (p. 3, [0046]). The PC (4) also

generates the watermark composition with its ID imprinter (18) (p. 2, [0035], lines

7-8).].

Regarding Claim 18: Ito discloses the system of claim 17, wherein the imaging-service

content comprises text [The imaging-service content includes the ID unique to the user,

which is added to the ID holder (Fig. 3, 16) by the content manager (p. 2, [0035], lines

9-11). This ID unique to the user is understood to be text.].

Regarding Claim 19: Ito discloses the system of claim 17, wherein the imaging-service

content comprises a graphic design [Since an image decoder (Fig. 3, 14) is used to

decode the imaging-service content it can be concluded that this content is an image or

graphic design. Also Ito uses an image as the content in his example (p. 2, [0034], lines

2-3).].

Regarding Claim 20: Ito discloses the system of claim 17, wherein the browser

comprises an imaging extension [See the analogous arguments made regarding claim

15.].

Regarding Claim 21: Ito discloses the system of claim 17, further comprising: a service

server coupled to the network and a service, wherein the service server receives data

from the browser [The detector (Fig. 11, 60), representing the service server, is

connected to the network (Fig. 1, 9) and a display service (Fig. 11, 68) (p. 4, [0060],

lines 3-7). The detector (60) reads the content after being imprinted with an ID by the

browser (Fig. 3, 12) (p. 4, [0060], lines 5-6).].

Regarding Claim 22: Ito discloses the system of claim 21, wherein the data comprises resource device commands [Since the detector (Fig. 11, 60) loads the content from a storage device (Fig. 10, S10), the data sent to the communication section (Fig. 11, 62) may be a memory address for accessing the content with imprinted ID (p. 4, [0059], line1-4). Therefore, providing the address acts as a read command for utilizing a resource device.].

Regarding Claim 23: Ito discloses the system of claim 21, wherein the data comprises links to access the watermark composition from the data storage device [Since the detector (Fig. 11, 60) loads the content from a storage device (Fig. 10, S10), the data sent to the communication section (Fig. 11, 62) may be a memory address for accessing the content with imprinted ID (p. 4, [0059], line1-4). Therefore, the memory address acts as a link.].

Regarding Claim 24: Ito discloses the system of claim 22, wherein the resource device commands are configured to direct the creation of a hard-copy product [Although no figure portrays a box for creating a hard-copy, Ito explains that once content is imprinted copying is enabled (p. 2, [0033], lines 10-11). This copying includes both digital copying and hard-copying.].

Regarding Claim 25: Ito discloses a computer-readable medium comprising computer readable instructions for:

- Receiving imaging-service content [The communication means (Fig. 3, 10) receives imaging-service content from the server (Fig. 1, 2) (p. 2, [0034], lines 5-8).];

- Extracting data reflective of a watermark image [The analogous selecting means of claim 9 is applicable.];

- Identifying at least one target composition designated for integration with the watermark image [The analogous identifying means of claim 9 is applicable.];

- Generating a watermark composition comprising the watermark image and the at least one target composition [The analogous associating means of claim 9 is applicable.];

- Storing the watermark composition [The analogous storing means of claim 9 is applicable.].

Regarding Claim 26: Ito discloses the program of claim 25, further comprising: redirecting the watermark composition to at least one service to generate a product [Although no figure portrays a box for creating a hard-copy, Ito explains that once content is imprinted copying is enabled (p. 2, [0033], lines 10-11). This copying is synonymous with generating a product.].

Regarding Claim 27: Ito discloses the program of claim 25, wherein receiving

comprises activity on an imaging-client device [The communication means (Fig. 3, 10)

belongs to the PC (Fig. 3, 4), which is an imaging-client device (p. 2, [0031], lines 3-5).].

Regarding Claim 28: Ito discloses the program of claim 25, wherein extracting data is

implemented with a browser [The analogous arguments of claim 11 are applicable to

claim 28.].

Regarding Claim 29: Ito discloses the program of claim 25, wherein identifying

comprises an imaging extension operative with a browser, wherein the imaging

extension communicates with a data-storage device [The analogous arguments of claim

14 are applicable to claim 29.].

Regarding Claim 30: Ito discloses the program of claim 26, wherein the at least one

service receives the forwarded content, the forwarded content comprising a link to the

watermark composition, the watermark composition residing within a personal-imaging

repository [The analogous arguments of claim 23 are applicable to claim 30.].

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

- Ha (Pub. No. US 2002/0032863 A1) is cited for teaching a web server with watermarking capability.

- Venkatesan et al. (PN 6,546,114) is cited for teaching watermark generation and detection utilizing a web server and client possessing a web browser.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Craig W Kronenthal whose telephone number is (703) 305-8696. The examiner can normally be reached on 8:00 am - 5:00 pm / Mon. - Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on (703) 306-6604. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CWK
02/28/05

MEHRDAD DASTOURI
PRIMARY EXAMINER